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05-21-03

CPA/1600 #19 DmJ 52703

PTO/SB/29 (2/98)

Approved for use through 09/30/2000. OMB 0651-0032

Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE

CONTINUED PROSECUTION APPLICATION (CPA) REQUEST TRANSMITTAL

Submit an original, and a duplicate for fee processing.

(Only for Continuation or Divisional applications under 37 C.F.R. § 1.53(d))

CHECK BOX, if applicable:

☐ **DUPLICATE**

Address to:

Commissioner for Patents

BOX CPA

Washington, DC 20231

Attorney Docket No.

PC10240A

First Named Inventor

Kim McClure

Examiner Name

John P. Weber

Group/Art Unit

1651

Express Mail Label No.

EL768267173US

This is a request for a ☒ continuation or ☐ divisional application under 37 C.F.R. §1.53(d), (continued prosecution application (CPA)) of prior application number 09/373,182 filed on August 12, 1999 entitled TACE INHIBITORS

NOTES

FILING QUALIFICATIONS: The prior application identified above must be a nonprovisional application that is either: (1) complete as defined by 37 C.F.R. §1.51(b) or (2) the national stage of an international application in compliance with 35 U.S.C. 371. A Notice will be placed on a patent issuing from a CPA, except for reissues and designs, to the effect that the patent issued on a CPA and is subject to the twenty-year patent term provisions of 35 U.S.C. §154(a)(2). Therefore, the prior application of a CPA may have been filed before, on or after June 8, 1995.

C-I-P NOT PERMITTED: A continuation-in-part application cannot be filed as a CPA under 37 C.F.R. §1.53(d), but must be filed under 37 C.F.R. §1.53(b).

EXPRESS ABANDONMENT OR PRIOR APPLICATION: The filing of this CPA is a request to expressly abandon the prior application as of the filing date of the request for a CPA. 37 C.F.R. §1.53(b) must be used to file a continuation, divisional or continuation-in-part of an application that is not to be abandoned.

ACCESS TO PRIOR APPLICATION: The filing of this CPA will be construed to include a waiver of confidentiality by the applicant under 35 U.S.C. 122 to the extent that any member of the public who is entitled under the provisions of 37 C.F.R. § 1.14 to access to, copies of, or information concerning, the prior application may be given similar access to, copies of, or similar information concerning, the other application or applications in the file jacket.

35 U.S.C. 120 STATEMENT: In a CPA, no reference to the prior application is needed in the first sentence of the specification and none should be submitted. If a sentence referencing the prior application is submitted, it will not be entered. A request for a CPA is the specific reference required by 35 U.S.C. 120 and to every application assigned the application number identified in such request, 37 C.F.R. 1.78(a).

1. ☒ Enter the unentered amendment previously filed on under 37 C.F.R. § 1.116 in the prior nonprovisional application.
2. ☒ A preliminary amendment is enclosed.
3. This application is filed by fewer than all the inventors named in the prior application, 37 C.F.R. §1.53(d)(4).
 - a. ☐ **DELETE** the following inventor(s) named in the prior nonprovisional application:

 - b. ☐ The inventor(s) to be deleted are set forth on a separate sheet attached hereto.
4. ☐ A new power of attorney or authorization of agent (PTO/SB/81) is enclosed.
5. ☐ Information Disclosure Statement (IDS) is enclosed:
 - a. ☐ PTO-1449
 - b. ☐ Copies of IDS Citations

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CONTINUED PROSECUTION APPLICATION PTO SB 29, 3/99

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CLAIMS	(1) FOR	(2) NUMBER FILED	(3) NUMBER EXTRA	(4) RATE	(5) CALCULATIONS
	TOTAL CLAIMS* (37 C.F.R. § 1.16(c) or (j))	4-20*=	0	x \$ 18=	\$ 0
	INDEPENDENT CLAIMS (37 C.F.R. § 1.16(b) or (i))	3 -3**=	0	x \$ 80 =	0
	* Based on 1.116 and Preliminary Amendment MULTIPLE DEPENDENT CLAIMS (if applicable) (37 C.F.R. § 1.16(d))			x \$ 270 =	
				BASIC FEE (37 C.F.R. § 1.16)	750
				Total of above Calculations =	750
	Reduction by 50% for filing by small entity (Note 37 C.F.R. §§ 1.9, 1.27, 1.28).				
	* Reissue claims in excess of 20 and over original patent.				Total =
	** Reissue independent claims over original patent.				750

6. Small entity status:

- a. ☐ A small entity statement is enclosed, if (b) and (c) do not apply.
- b. ☐ A small entity statement was filed in the prior nonprovisional application and such status is still proper and desired.
- c. ☐ Is no longer claimed.

7. The Commissioner is hereby authorized to credit overpayments or charge the following fees
Deposit Account No. 16 - 1445:

- a. ☒ Fees required under 37 C.F.R. §1.16.
- b. ☐ Fees required under 37 C.F.R. §1.17.
- c. ☐ Fees required under 37 C.F.R. §1.18.

8. ☐ A check in the amount of \$ _____ is enclosed.9. ☐ Other:

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NOTE: The prior application's correspondence address will carry over to this CPA
UNLESS a new correspondence address is provided below.

10. NEW CORRESPONDENCE ADDRESS

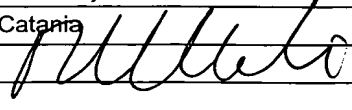
☒ Customer Number or Bar Code Label

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or ☒ New Correspondence address below

Name	Paul H. Ginsburg				
Address	Pfizer Inc				
Address	235 East 42nd Street, 20th Floor				
City	New York	State	New York	Zip Code	10017-5755
Country	United States Of America	Telephone	(212)573-2369	Fax	(212)573-1939

11. SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT REQUIRED

NAME (Print Type)	Richard L. Catania
Signature	
Registration No. (Attorney/Agent)	32,608
Date	May 22, 2003

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#24D
Dmt
5-27-03

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF: Kim McClure *et al* :

Examiner: John P. Weber

APPLICATION NO.: 09/373,182 :

Group Art Unit: 1651

FILING DATE: August 12, 1999 :

TITLE: TACE INHIBITORS :

Mail Stop CPA

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

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PRELIMINARY AMENDMENT - REMARKS

Applicants hereby provide new claims and remarks to the Advisory Action issued in USSN 09/373182 on November 19, 2002.

Procedurally: a Notice of Appeal was filed (stamped) October 21, 2002. In lieu of briefing otherwise due May 21, 2003 with appropriate time extensions, Applicants provide the instant submission together with a Continuation Prosecution Application request.

Favorable (re)consideration is requested.

IN THE CLAIMS

Please add new claim 82:

82. (NEW) A method of inhibiting the cleavage of TNF- α from cell membranes without inhibiting MMP-1 in a mammal comprising: administering to said mammal an effective amount of a hydroxamic acid compound that possesses at least 100 fold IC₅₀ selectivity for TACE over MMP-1, said hydroxamic acid compound comprising a (C₆-C₁₀)aryl(C₁-C₆)alkoxy(C₆-C₁₀)aryl, (C₆-C₁₀)aryl(C₁-C₆)alkoxy(C₂-C₉)heteroaryl, (C₂-C₉)heteroaryl(C₁-C₆)alkoxy(C₆-C₁₀)aryl, or (C₂-C₉)heteroaryl(C₁-C₆)alkoxy(C₂-C₉)heteroaryl wherein each of said (C₆-C₁₀)aryl or (C₂-C₉)heteroaryl groups may optionally be substituted by one or more substituents independently selected from

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